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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,535	04/27/2006	Bing Zhu	20807-002US1 FPCH06160002	9801
26161	7590	10/20/2008	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	
			NOTIFICATION DATE	DELIVERY MODE
			10/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/577,535	Applicant(s) ZHU, BING	
	Examiner MISOOK YU	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 2, 5, 6, drawn to protein comprising SEQ ID NO: 2 and variants.

Group II, claim(s) 3, 4, 7-9, drawn to gene sequence, vector, host cell.

Group III, claim(s) 10-16 drawn to method of treatment.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: claim 1 lacks the special technical feature since one species of the claimed protein is deletion and addition mutant of SEQ ID NO: 2 is anticipated by US Pat. No. 6284236. Note the sequence comparison.

RESULT 5

US-09-320-424-13

; Sequence 13, Application US/09320424
; Patent No. 6284236
; GENERAL INFORMATION:
; APPLICANT: Wiley, Steven R.
; APPLICANT: Goodwin, Raymond G.
; TITLE OF INVENTION: Cytokine that Induces Apoptosis
; FILE REFERENCE: 2835-E
; CURRENT APPLICATION NUMBER: US/09/320,424
; CURRENT FILING DATE: 1999-05-26
; EARLIER APPLICATION NUMBER: 09/190,046
; EARLIER FILING DATE: 1998-11-10
; EARLIER APPLICATION NUMBER: 09/048,641
; EARLIER FILING DATE: 1998-03-26
; EARLIER APPLICATION NUMBER: 08/670,354
; EARLIER FILING DATE: 1996-06-25
; EARLIER APPLICATION NUMBER: 08/548,368
; EARLIER FILING DATE: 1995-11-01

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; EARLIER APPLICATION NUMBER: 08/496,632
; EARLIER FILING DATE: 1995-06-29
; NUMBER OF SEQ ID NOS: 25
; SOFTWARE: PatentIn Ver. 2.0
; SEQ ID NO 13
; LENGTH: 256
; TYPE: PRT
; ORGANISM: synthetic fusion
US-09-320-424-13
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Query Match          88.5%; Score 779; DB 2; Length 256;
Best Local Similarity 100.0%; Pred. No. 9.9e-78;
Matches 147; Conservative 0; Mismatches 0; Indels 0; Gaps
0;
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Qy      1 TLSSPNSKNEKALGRKINSWESSRSGHSFSLNLHLRNGELVIHEKGFYIYSQTYFRFQE 60
          ||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db      110 TLSSPNSKNEKALGRKINSWESSRSGHSFSLNLHLRNGELVIHEKGFYIYSQTYFRFQE
169

Qy      61 EIKENTKNDKQMVQYIYKYTSYPDPILLMKSARNSCWSKDAEYGLYSIYQGGIFELKEND
120
          ||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db      170 EIKENTKNDKQMVQYIYKYTSYPDPILLMKSARNSCWSKDAEYGLYSIYQGGIFELKEND
229

Qy      121 RIFVSVTNEHLIDMDHEASFFGAFLVG 147
          ||||||||||||||||||||||||
Db      230 RIFVSVTNEHLIDMDHEASFFGAFLVG 256
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As for the same activity as the instant SEQ IDNO: 2, the protein of the patent has apoptotic activity. Neither the claims nor the specification defines what is meant by "the same activity". Therefore, it is concluded that the apoptotic activity belong to the same activity.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does

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not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MISOOK YU
Primary Examiner
Art Unit 1642

/MISOOK YU/
Primary Examiner, Art Unit 1642